

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	BENSON, S.R.	)	
Serial No.	08/618,259	)	
Filed:	March 18, 1996	)	
Patent No.	5,720,681	)	
Reissue Filed:	April 8, 2004	)	
Title:	Torque Responsive Actuation	)	<b>Declaration</b>
	Device	)	

**Declaration**

1. On April 6, 2004, I telephoned the attorney of record, M. Reid Russell, to discuss U.S. Patent Nos. 5,516,333 and 5,720,681, ("the '333 and '681 Patents").

2. I asked Mr. Russell why the '681 Patent did not claim priority to the '333 Patent, given that Claim 1 of the '681 Patent claimed subject matter disclosed in the '333 Patent.

3. Mr. Russell responded that the applicant approached him after the '333 Patent had issued and only then did the applicant reveal the embodiment disclosed in the '681 Patent.


4. Mr. Russell stated that the '681 Patent was not copending with the '333 Patent and therefore a claim for priority would not have been appropriate.

5. Mr. Russell stated that no claim for priority was made because there was no copendency between the '333 and '681 Patent applications.

6. I informed Mr. Russell that indeed the '333 and '681 Patent applications were copending. He stated that he may have confused matters at the time. He was generally confused as to the events and as to why he didn't claim priority to the '333 Patent application in the '681 Patent application.

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

April 8, 2004

  
John F. Klos

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant:	BENSON, S.R.	)	
Serial No.	08/618,259	)	
Filed:	March 18, 1996	)	
Patent No.	5,720,681	)	
Reissue Filed:	April 8, 2004	)	
Title:	Torque Responsive Actuation	)	<b>Declaration</b>
	Device	)	

**Reissue Application Declaration by the Inventor**

1. I am the inventor of U.S. Patent Nos. 5,516,333 and 5,720,681 (the '333 Patent and the '681 Patents, respectively). The '681 Patent has not been assigned. I am a resident of Murray, Utah, and have a mailing address of 5919 S. 350 West, P.O. Box 67547, Murray, Utah, 84107. I am a citizen of the United States.

2. I believe I am the original, first and sole inventor of the subject matter which is described and claimed in the '681 Patent, which granted on February 24, 1998, and is entitled Torque Responsive Actuation Device. The specification of the '681 Patent is attached hereto.

3. I have reviewed and understand the contents of the '681 Patent, including the claims. I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

4. I believe the '681 Patent to be wholly or partly inoperative or invalid, for the reasons described below. All errors corrected in this reissue application arose without any deceptive intent on my part.

**Background:**

5. In 1994, I met with my patent attorney, Mr. Russell, to discuss my invention for Torque Responsive Actuation Devices. At that time, we discussed two embodiments of the invention, the first "cylindrical roller / radiused cam" version and the second "radiused roller /

flat cam” version. I then directed Mr. Russell to prepare a United States utility patent application which would protect both embodiments of the invention.

6. Mr. Russell prepared a first utility patent application, which was subsequently granted as the ‘333 Patent. The ‘333 Patent was filed on October 17, 1994, and disclosed only the first “cylindrical roller / radiused cam” embodiment. The ‘333 Patent was given Ser. No. 08/323,611.

7. After the ‘333 Patent was filed, I contacted Mr. Russell to question why the second embodiment of the invention, the “radiused roller / flat cam” embodiment, was missing from the ‘333 Patent application. I was concerned because I had directed him to obtain patent protection for both embodiments of the invention.

8. After that contact with Mr. Russell, he proceeded to prepare a second patent application which included the second embodiment of the invention.

9. The second patent application, which ultimately was granted as the ‘681 Patent, was filed on March 18, 1996.

10. The ‘681 Patent application was filed before the issue date (May 14, 1996) of the ‘333 Patent and therefore the two applications were co-pending.

11. During the prosecution of the ‘681 Patent application, claims 1-7 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 through 9 of my co-pending ‘333 Patent. A terminal disclaimer was subsequently filed to overcome this rejection.

12. During the prosecution of the ‘333 Patent, I informed Mr. Russell that the invention disclosed in the ‘333 Patent application (the first embodiment) was publicly shown prior to March 18, 1995.

13. In or around 1998, I became aware that a product manufactured by Arctic Cat may infringe my '681 Patent. My attorneys contacted Arctic Cat in a letter dated October 8, 2002.

14. In the letter of October 8, 2002, my attorneys stated that the '681 Patent was being infringed by Arctic Cat.

15. In a response dated April 16, 2003, Arctic Cat's attorneys stated :

“Although the application resulting in your client's U.S. Patent No. 5,720,681 was co-pending with the prior application of your client resulting in U.S. Patent No 5,516,333, your client failed to properly claim priority under 35 U.S.C. §120; and therefore, Application Serial No. 618,259 is only entitled to its filing date of March 18, 1996. Most significantly, your client in the IDS filed on or about March 18, 1996 identified the disclosure of U.S. Patent Application Serial No. 08/323,611 as prior art. From this, I can only assume that the transmission device of the '333 patent was either on sale or disclosed to others in the United States prior to the invention of the '681 patent or prior to March 18, 1995.”

16. In that same response, Arctic Cat's attorneys state “either claims 1-3 are invalid over the prior art disclosure of the '333 patent or they fail to claim the invention of the '681 patent.”

17. I have attached a complete copy of Arctic Cat's response as Exhibit A.

18. Upon reviewing this letter, I directed my attorneys to assess the validity of Arctic Cat's allegations that claims 1 – 3 of the '681 Patent were invalid.

19. I was subsequently informed by my attorneys that the '681 Patent did not claim priority to the '333 Patent application, even though the two applications were co-pending and claims of the '681 Patent were disclosed in the '333 Patent application.

20. I was also informed that the benefit of the filing date of the '333 Patent was needed, given the public disclosure of my invention prior to March 18, 1995.

**Errors supporting Reissue:**

21. As claim 1 of the '681 Patent is directed to subject matter disclosed in the '333 Patent, I believe my attorney's failure to claim priority to the '333 Patent application was in error.

22. One error in the '681 Patent which provide grounds for a reissue of the patent is the failure to make reference to the prior co-pending '333 Patent application.

23. Regarding the Information Disclosure Statement of March 18, 1996, I believe it was an error to state that the disclosure of U.S. Patent Application Serial No. 08/323,611 was prior art.

24. The requirements set forth in 37 CFR 1.78(a)(1) have been met in the application which became the '681 Patent. The '681 Patent application was co-pending with the '333 Patent application. I am the inventor of both the '333 Patent and the '681 Patent and the '333 Patent application discloses my invention claimed in at least one claim of the later filed '681 Patent.

**Conclusion:**

25. I appoint John F. Klos, Registration Number 37, 162, of Fulbright & Jaworski LLP, 2100 IDS Center, 80 South Eighth Street, Minneapolis, MN 55402, to prosecute this application and transact all business in the United States Patent and Trademark Office connected herewith.

26. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

April 8, 2004



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April 16, 2003

Alan M. Anderson  
Fulbright & Jaworski  
225 South Sixth Street, Ste. 4850  
Minneapolis, MN 55402-4320

Re: Investigation of U.S. Patent No. 5,720,681  
M&G 7432.177-US-AA

Dear Alan:

I wish to acknowledge your letter of March 25, 2003. I am writing to respond to your client's royalty offer. Unfortunately, my client believes the royalty to be much too high for what it would be getting under this patent.

Although the application resulting in your client's U.S. Patent No. 5,720,681 was co-pending with the prior application of your client resulting in U.S. Patent No. 5,516,333, your client failed to properly claim priority under 35 U.S.C. §120; and therefore, Application Serial No. 618,259 is only entitled to its filing date of March 18, 1996. Most significantly, your client in the IDS filed on or about March 18, 1996 identified the disclosure of U.S. Patent Application Serial No. 08/323,611 as prior art. From this, I can only assume that the transmission device of the '333 patent was either on sale or disclosed to others in the United States prior to the invention of the '681 patent or prior to March 18, 1995.

The invention of the '681 patent was to improve upon the invention of the '333 patent, see column 1, lines 33-40. The invention of the '333 patent provided the helix cam tracks being radiused or presenting a convex surface. Claims 1-3 of the '681 patent, which provide for either the cam tracks surface to be radiused or the roller contact surface to be radiused, read upon the disclosure of the '333 patent. Thus, either claims 1-3 are invalid over the prior art disclosure of the '333 patent or they fail to claim the invention of the '681 patent.

I think your client would agree that claims 4-7 of the '681 patent add nothing new to transmissions which were known in the prior art.

Assuming the invention of the '681 patent can be construed to be limited to a convex roller, even this has been known to be old in the prior art.

Minneapolis/St. Paul  
Denver  
Seattle  
Atlanta  
Washington, DC

Alan M. Anderson

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Arctic Cat, prior to 1996, had used spherical bearings in snowmobile drive shafts since 1970 and snowmobile steering columns since 1989. See also U.S. Patent Nos. 3,224,287 and U.S. Patent No. 3,722,308 which disclose rollers with a convex surface in transmission systems. See enclosures.

A further factor considered by my client is the fact that it can modify its rollers either to go back to its prior cylindrical surface roller or to a roller with a central portion having a cylindrical surface.

In spite of our belief that your client has little to offer, Arctic Cat is willing to make a reasonable offer to your client.

In return for a paid up, royalty free license under U.S. Patent No. 5,720,681 for the term of said patent, Arctic Cat will pay to your client, the lump sum amount of \$ ~~100,000~~.

Under the circumstances, I consider this to be a very reasonable offer; and I hope this can be amicably resolved in the near future.

Yours very truly,

  
John D. Gould

JDG/jms

cc: Ole Tweet